

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Docket No.: P26741

F. KNAUSEDER

Confirmation No.: 2541

Serial No.: 09/814,066

Group Art Unit: No. 3637

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Examiner: M. Safavi

For: **FLOORING PANELS**

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

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Sir:

This Reply Brief is in response to the Examiner's Answer dated March 6, 2009,
the period for reply extending until May 6, 2009.

The Examiner maintains the grounds of rejection advanced in the final rejection of claims 1-3, 21-24 and 31-36, and provides arguments traversing the arguments presented by Appellant in the Appeal Brief filed on November 28, 2008.

Appellant notes this Reply Brief is being filed under 37 C.F.R. 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellant notes it is addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

On page 10 of the Examiner's Answer, the Examiner characterizes Appellant's argument regarding the definition of "pre-applied adhesive" as being specifically limited to the adhesive disclosed in the prior art document to AZEVEDO (discussed in the Appeal Brief). This is a mischaracterization of Appellant's argument.

Appellant has clearly argued that the term "pre-applied adhesive" has a specific meaning in the art, that the prior art document to AZEVEDO provides evidence that the term has the meaning which Appellant believes the Examiner is ignoring, and that this specific meaning is fully consistent with Appellant's specification.

Again, in the Appeal Brief, Appellant clearly stated the following:

Appellant again notes that U.S. Patent No. 4,417,028 to AZEVEDO (a copy of which has been made of record in the instant application) contains an accurate description of such substances. Such substances are typically stable compositions which are prepared and pre-applied to "surfaces prior to the time of assembly, which will remain on the parts during normal storage and shipment, and which will cure upon mating with another part thereby imparting an effective and improved seal or bond." See col. 1, lines 56-68 of AZEVDO. Such substance also typically ensure that the pre-applied parts "can then be shipped or stored for substantial periods of time prior to cure" and are "dry to the touch". Finally, such substances may also have the attribute that "when crushed or ground by a mating surface, cures to a strong bond" (see col. 2, lines 1-22 of AZEVDO). Indeed, these properties, as well as other properties, are specifically acknowledged and noted on pages 5-14 of the instant specification in discussing examples of the types of substances which can be utilized in the invention.

As is clear from the noted language, the term "pre-applied adhesive", as recited in the claims, has a specific meaning in the art and the Examiner is simply not free to ignore this meaning in favor of one which suits the Examiner.

Second Issue

On page 10 of the Examiner's Answer, the Examiner asserts that he may broadly construe the term "pre-applied adhesive" as "any ordinary adhesive" because Appellant has discussed contact adhesives on lines 1-3 of page 6 of Applicant's specification. Appellant respectfully disagrees.

With regard to the argument that the term "pre-applied adhesive" can be disclosed by "any ordinary adhesive", Appellant notes that this argument specifically ignores the argument made above in the "First Issue".

With regard to the argument that the term "pre-applied adhesive" can be disclosed by "any ordinary adhesive" because Appellant has discussed contact adhesives on lines 1-3 of page 6 of Applicant's specification, Appellant notes that while the instant specification discusses numerous possible substances which can be applied off-site, the specification DOES NOT state that "any ordinary adhesive" can be utilized.

Appellant notes that the specification language, i.e., page 6, lines 1-6, cited by the Examiner discusses specific types of contact glues as follows:

Other glues suitable for use are contact glues which are applied as a solution or dispersion to the substrates being glued and which develop their adhesive effect after evaporation of the solvent, i.e., when the glue films are evidently dry, and under the effect of pressure exerted when the panels are joined. The base polymers of the contact glues are primarily polyacrylates, polychloroprenes, nitrile or styrene butadiene rubber, and polyurethanes. They may additionally contain tackifying resins, such as colophonium, hydrocarbon resins, or phenol resins.
Emphasis Added.

The noted language is far from describing “any ordinary adhesive”, and is, in point of fact, clearly supportive of and consistent with the adhesive definition evidenced by AZEVEDO.

Thus, Appellant’s specification IS NOT supportive of the Examiner’s argument that the term “pre-applied adhesive” can be disclosed by “any ordinary adhesive”.

Third Issue

On page 10 of the Examiner’s Answer, the Examiner alternatively asserts that he may broadly construe the term “pre-applied adhesive” as the adhesive of DE ‘962 because Appellant has discussed contact adhesives on lines 1-3 of page 6 of Applicant’s specification. Appellant respectfully disagrees.

Again, this argument specifically ignores the argument made above in the “First Issue”. Nor can the term “pre-applied adhesive” be disclosed by the adhesive of DE ‘962 because Appellant has discussed contact adhesives on lines 1-3 of page 6 of Applicant’s specification.

As explained above, while the instant specification discusses “contact adhesives”, the specification DOES NOT state that any “contact adhesive” can be utilized. To the contrary, the noted specification language, i.e., page 6, lines 1-6, cited by the Examiner discusses specific types of contact glues as follows:

Other glues suitable for use are contact glues which are applied as a solution or dispersion to the substrates being glued and which develop their adhesive effect after evaporation of the solvent, i.e., when the glue films are evidently dry, and under the effect of pressure exerted when the panels are joined. The base polymers of the contact glues are primarily polyacrylates, polychloroprenes, nitrile or styrene butadiene rubber, and polyurethanes. They may additionally contain

tackifying resins, such as colophonium, hydrocarbon resins, or phenol resins.
Emphasis Added.

Rather than explain how the disclosed adhesive of DE '962 can be interpreted to disclose the recited "pre-applied adhesive" consistent with the specification, the Examiner has merely argued (incorrectly) that the specification supports the Examiner's position that any contact adhesive can be used, when, in fact, this is not the case.

The type of the contact adhesive which can properly be described as "pre-applied adhesive" consistent with the specification is simply not disclosed by DE '962, and the Examiner has not demonstrated otherwise.

Thus, Appellant's specification IS NOT supportive of the Examiner's argument that the term "pre-applied adhesive" can be disclosed by the so-called "contact adhesive" of DE '962.

Fourth Issue

On page 10 of the Examiner's Answer, the Examiner also asserts that he may broadly construe the term "pre-applied adhesive" as the adhesive of DE '962 because Appellant has discussed other types adhesives in Applicant's specification such as on: lines 19-23 of page 5, lines 1-5 of page 6, and page 8, line 22 to page 9, line 17. Appellant respectfully disagrees.

Again, this argument specifically ignores the argument made above in the "First Issue". Nor can the term "pre-applied adhesive" be disclosed by the adhesive of DE '962 because Appellant has discussed contact adhesives on lines 19-23 of page 5, lines 1-5 of page 6, and page 8, line 22 to page 9, line 17 of Applicant's specification.

As explained above, the noted specification language of page 6, lines 1-6 cited by the Examiner discusses specific types of contact glues as follows:

Other glues suitable for use are contact glues which are applied as a solution or dispersion to the substrates being glued and which develop their adhesive effect after evaporation of the solvent, i.e., when the glue films are evidently dry, and under the effect of pressure exerted when the panels are joined. The base polymers of the contact glues are primarily polyacrylates, polychloroprenes, nitrile or styrene butadiene rubber, and polyurethanes. They may additionally contain tackifying resins, such as colophonium, hydrocarbon resins, or phenol resins. Emphasis Added.

The specification language of page 5, lines 19-24 discusses specific types of glues as follows:

Specific glues that can be used in the context of the invention are mentioned in the following. Suitable are both fully synthetic glues, such as artificial resin glues, e.g., polyvinyl acetate wood glue, as well as those of vegetable origin, such as dextrin, starch, sago or tapioca glue, and of animal original, such as skin, leather, bone, and casein glues. In addition to the already mentioned physically setting cements, chemically setting glues can be employed, such as those based on urea, melamine, phenol, or cresol resins.

While such language is suggestive of using many known glues, such language is not intended to broaden the meaning of the recited “pre-applied adhesive”. To the extent that such glues operate as a “pre-applied adhesive”, then such glue substance can be said to be consistent with the specification. However, this specification language specifically does not state that the term “pre-applied adhesive” is to be interpreted to encompass all known glues. This is a conclusion reached by the Examiner and NOT supported by Appellant’s specification.

The specification language of page 8, line 22 to page 9, line 17 discusses specific types of glues as follows:

Another type of adhesion available for the panels of the new floor covering has proven to be advantageous as based on favorable test results and experiences; here the grooves and/or tongues of the panels are covered or coated with an adhesive glue, particularly with a molten adhesive glue. Adhesive glues are visco-elastic glues which remain permanently sticky and adhesive at room temperature and, given a low substrate specificity, adhere to almost all substrates when subjected to light pressure. The base polymers for modern adhesive glues are natural and synthetic rubbers, polyacrylates, polyesters, polychloropropenes, polyisobutenes, polyvinyl ethers, and polyurethanes, which are employed in combination with additives, such as other resins, softeners, and/or antioxidants. As a rule, adhesive glues are applied as solutions or dispersions in, or on, the form-fitting elements.

Molten adhesive glues, on the other hand, are applied in a molten gel condition, where the molten glue can be applied in the form of a coating, layer, or strand, or by means of a hot-spray application. Adhesive glues differ from so-called constructive glues, that is, from, e.g., chemically reactive glues, in that they are lastingly sticky and permanently adhesive. Merely by being pressed against the surface of the piece being joined these glues induce a moistening of the latter's surfaces, thereby providing sufficient adhesive forces. The decisive parameters in gluing the tongue-groove panels are the pressure force and the quantity of applied glue. Though not a problem in the context of panel production, special attention must be paid to the quantity of applied glue, since there will be insufficient moistening when too little glue is present. If the quantity of glue is excessive, a gap that is too large remains after the panels have been joined, since the glue cannot be displaced, and this is a disadvantage, though one that no longer occurs when the glue is applied at the manufacturing site. Adhesive glues that are applied from the melt--i.e., the so-called molten adhesive glues--have an advantage in that they can be applied with a sufficient layer thickness, allowing the problem described above concerning the excessive thinness of glue layers to be circumvented; they have the further advantage of permitting a very precise dosing.

While such language is suggestive of using many known glues, it is only the glue substances which are consistent with a "pre-applied adhesive", such as those which are activated by pressure, that are encompassed by the claim term "pre-applied adhesive".

Thus, Appellant's specification IS NOT supportive of the Examiner's argument that the term "pre-applied adhesive" can be disclosed by any adhesive or glue which is mentioned in Appellant's specification.

Fifth Issue

On page 11 of the Examiner's Answer, the Examiner asserts that the meaning of "pre-applied adhesive" as used in the claims can be interpreted to be simply an adhesive or glue which is merely applied to the panels "prior to actual joining of the members". Appellant disagrees.

Again, this argument specifically ignores the argument made above in the "First Issue". Furthermore, this argument represents the Examiner trying to argue contrary views. Does the Examiner believe that Appellant's specification defines the term "pre-applied adhesive" as merely any adhesive or glue which is merely applied to the panels "prior to actual joining of the members"? If so, Appellant is unaware of any language in the claims or in Appellant's specification that would support this argument.

The Examiner's argument also fails to address Appellant's argument that the "broadest reasonable interpretation" standard must be one that "would be understood by one of ordinary skill in the art, taking into consideration the description of the applicant's specification. *In re Morris*, 127 F.3D 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)". See page 3 of the non-precedential decision *Ex parte HADDAD* (submitted with the Rule 1.116 Amendment). At the very least, Appellant is entitled to a definition of "pre-applied" which Appellant has established during prosecution. See page 4 of the non-precedential decision *Ex parte HADDAD*. The Examiner's assertions essentially ignore this point, and the meaning provided to the language during prosecution and which is supported by the specification.

Sixth Issue

On pages 11 and 12 of the Examiner's Answer, the Examiner asserts that the meaning of "pre-applied adhesive" as used in the claims can be interpreted to mean only when the adhesive is applied instead of the type of adhesive evidenced in AZEVEDO because Appellant's appealed claim 34 recites both a pre-applied first layer and a pre-applied second layer. Appellant disagrees and submits that the Examiner appears to be missing the point of this argument.

The relevance of these layers of adhesive or adhesive substance specifically supports Appellant's definition of "pre-applied adhesive" as one that was specifically and clearly explained in the Appeal Brief as follows:

Appellant emphasizes that, according to the invention, the application of the adhesive or the substance at least to corresponding divergent surfaces of the tongue and groove and connecting the tongue and groove, causes the tongue to become bonded to the groove by virtue of the divergent surfaces being pushed and remaining in tension. This ensures an especially reliable bonding of the connection. Furthermore, because of the substance placement and the use of the locking elements, the arrangement is such that locking elements help ensure that the substance on the divergent sides cannot come up and out of the connection onto the surface of the panels. Thus, the locking elements act as a locking device and as a device which prevents the spilling out of the adhesive substance. The pre-application of the adhesive or substance at least on the divergent sides also ensures it does not find its way into the locking elements, i.e., thereby ensuring a totally flat surface in the area of the connection of the panels. This is not the case in any of the prior art documents.

This description is clearly MORE THAN a discussion of "when" an adhesive is applied, and is not rendered obvious by the applied documents.

Seventh Issue

On pages 12-14 of the Examiner's Answer, the Examiner disagrees with Appellant that the applied documents teach away from their combination, but does not specifically address Appellant's specific points noted in the Appeal Brief.

Appellant has pointed out that DE '962, at best, teaches the mere factory application of an adhesive to form a joint at the factory, and that AT '560 lacks any adhesive at all. As such, one having ordinary skill in the art following the path set out in DE '962 would not seek to add the adhesive of DE '962 to AT '560. This is because DE '962 at least specifically teaches away from using an adhesive which is of the "pre-applied" type as discussed below, i.e., an adhesive that is applied in one location, i.e., off-site, and then activated in another location, e.g., on site. The Examiner responds by explaining that DE '962 does teach applying adhesive off-site – again implying that "when" an adhesive is applied is the proper interpretation of the claim language; rather than the type of adhesive that is actually recited in the claims.

Appellant has pointed out that DE '962 teaches to use adhesive in a non-locking tongue and groove joint and that AT '560 teaches a locking tongue and groove joint without any adhesive. As such, one having ordinary skill in the art, following the path set out in either AT '560 or DE '962, simply would not seek to add the adhesive of DE '962 to the panels of AT '560. Again, this is because, unlike AT '560, DE '962 specifically does not require any adhesive to produce a secure or locking joint. The Examiner again discusses how DE '962 teaches to apply adhesive off-site, again alleging that "when" an

adhesive is applied is the proper interpretation of the claim language; rather than the type of adhesive that is actually recited in the claims. The Examiner further responds that a joint using the adhesive of DE '962 would be secure whether of the locking type or not. This, of course, ignores the fact that the use of both the recited "pre-applied adhesive" and a locking joint IS NOT disclosed or suggested in the applied art.

Appellant also pointed to the apparently non-precedential decision *Ex parte BLAICHER* (submitted with the Rule 1.116 Amendment) which, in the paragraph bridging pages 5-6, explains that obviousness cannot be found when prior art disclosures teaches away from their combination by doing the opposite, i.e., one reference specifically teaches to store information while the other specifically teaches not to store information. This is analogous to AT '560 teaching not to use any adhesive in the disclosed joint, while DE '960 teaches to use adhesive; which is the opposite of not using adhesive. This is also analogous to DE '960 disclosing the use of an adhesive in a joint that is formed essentially right after the application of the adhesive and/or at the same location. This is arguably the opposite of AT '560 which teaches not to use any adhesive in the disclosed joint at any time. Furthermore, by applying adhesive to a joint essentially contemporaneously with the joining of the panels, DE '960 also teaches precisely the opposite of the invention which specifically requires the application of a pre-applied adhesive or substance off-site. No comment was made by the Examiner in reference to *Ex parte BLAICHER*.

Appellant also identified the deficiencies of these documents as simply to notable to be ignored. For example, AT '560 does not teach the use of any adhesive in a locking tongue and groove joint. In fact, it would be unnecessary to use an adhesive in AT '560, as it already includes a locking joint. Moreover, DE '962 merely discloses a contact glue which requires that the mating surfaces "be pressed together with a considerable degree of pressure, making it impossible to additionally adjust the glued joint in the longitudinal direction for the purpose of closing a transverse joint." Thus, even if these documents were properly combinable (which Appellant disputes), they would nevertheless not disclose or suggest the unique combination of three features in the connection of flat structural panels: that is, (1) a tongue and groove connection with divergent sides; (2) that both the tongue and the groove have a locking mechanisms or elements; and (3) that either the tongue, or the groove, or both of these devices, have a pre-applied adhesive or an adhesive substance as defined above. The Examiner responds that a joint using the adhesive of DE '962 would be secure whether of the locking type or not; however, the Examiner never acknowledges that the use of both the recited "pre-applied adhesive" and a locking joint IS NOT disclosed or suggested in the applied art.

Eighth Issue

On pages 14-16 of the Examiner's Answer, the Examiner apparently acknowledges Appellant's argument that the invention utilizes the application of the adhesive or the substance at least to corresponding divergent surfaces of the tongue and groove so as to cause the tongue to become bonded to the groove by virtue of the

divergent surfaces being pushed and remaining in tension and ensures an especially reliable bonding of the connection. The Examiner explains, however, that the applied art somehow teaches these features. Appellant disagrees.

In the invention, because of the substance placement and the use of the locking elements, the arrangement is such that locking elements help ensure that the substance on the divergent sides cannot come up and out of the connection onto the surface of the panels. Thus, the locking elements act as a locking device and as a device which prevents the spilling out of the adhesive substance. The pre-application of the adhesive or substance at least on the divergent sides also ensures it does not find its way into the locking elements, i.e., thereby ensuring a totally flat surface in the area of the connection of the panels. This IS NOT the case in any of the prior art documents.

CONCLUSION

Accordingly, in view of the above-noted arguments (as well as those already of record), the Board is respectfully requested to reverse the Examiner's decision to finally reject claims 1-3, 21-24 and 31-36 under 35 U.S.C. § 103(a), and that the application be remanded to the Examiner for withdrawal of the rejection over the applied documents and an early allowance of all claims on appeal. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 19-0089.

Respectfully submitted,
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